

Interview Summary

Application No.

09/773,976

Applicant(s)

SUN ET AL.

Examiner

Francis P Moonan

Art Unit

1638

All participants (applicant, applicant's representative, PTO personnel):

(1) Dr. Francis P Moonan, Patent Examiner.

(3) Dr. Paul Sun, Inventor.

(2) Jill A. Fahrlander, (Reg. No. 42,518).

(4) Michael Velde, Inventor.

Date of Interview: 08 July 2002.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____.

Claim(s) discussed: 2-6,9 and 10.

Identification of prior art discussed: Northrup et al (Claims 2-4) and Sun et al (Claims 5-6 and 9-10).

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☐ It is not necessary for applicant to provide a separate record of the substance of the interview(if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180/63f

(Signature)

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135 (35 U.S.C. 132).

37 CFR §1.2 Business to be transacted in writing

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiner's Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

The examiner explained that although many issues remained unresolved, issues involving the 35 U.S.C. 112 written description and enablement rejections of the Office Action of Paper No. 5 appeared to be the most difficult issues to resolve. The examiner discussed that the specification as filed described the DS9705Hyb invention as a synthetic made from a combination of several synthetics, and in accordance with the 35 U.S.C. 112 rejections of Paper No. 5, it was unclear what the genetic constitution of DS9705 was; or if an enabling deposit representative of the broadly claimed invention could be successfully performed in accordance with the Budapest Treaty and 35 U.S.C 112.

The inventor Dr. Paul Sun, offered clarifying information that the DS9705hyb invention, whose pedigree was disclosed in the instant specification, for example on page, 2, lines 6-10, was made from individually selected clones of the synthetic variety populations listed in the pedigree. The inventor clarified for example that the individually selected Thor clone that he chose from the Thor population, was chosen on the basis of its disease resistance characteristics, and other criteria. The inventor clarified that some of which (eg. A833) were established for the making of a Syn1 generation of DS9705Hybe, by vegetative propagation, since they were male infertile, per common synthetic variety practice, with use of a maintainer line of B209. The inventor Dr. Paul Sun further directed that the DS9761 also is a selected individual from a synthetic variety.

The examiner indicated that the information clarified some of the genotypic and phenotypic descriptions, but that this clarifying information being provided by the inventor would be New Matter if amended to the instant specification. The examiner explained that no New Matter could be allowed in amendment to the instant specification of the currently filed application, but that said new matter could be incorporated in a Continuation-In-Part (C-I-P) application, which would claim priority to the instant application. The examiner further indicated that other criteria in the making of said synthetic variety would be considered favorably by the examiner for inclusion in a C-I-P, including: the planting-block design used to make the hybrid; the acreage or planting density used to make the synthetic variety invention; and the number of plants used to make the Syn-1 generation of the invention.

Attorney Jill Farlander inquired as to the opinion of the examiner as to whether the PCT application from which the instant application claimed priority would be considered as the earliest filing date. The examiner indicated that it was his nonbinding opinion, subject to approval of his supervisors, that provided the breadth of the claims, that the PCT would appear to be acceptable as the earliest filing date, if a C-I-P were filed.

Attorney Jill Farlander requested an opinion of the examiner on the 35 U.S.C. 103(a) rejection of Claims 5, 6, and 9-10, as obvious over Sun et al, which involved the obviousness of increased planting ratios of a method. The examiner indicated that no opinion could be rendered on the issue of ratios themselves; but that it was his opinion that the rejections could be obviated if the claims were limited to specific clonal plant lines in the making of a synthetic variety.

Dr. Sun requested an opinion on the Novelty and Obviousness of the invention, in view of the use of a single Thor clone selection being used in the making of the invention. The examiner asked Dr. Sun if he expected some proportion of the individually selected Thor clone in the seed, as that would be the examiner's interpretation. Dr. Sun acceded to the Examiner's interpretation. The examiner explained, that because of the nature of the disclosure in the instant specification, which currently reads on the entire Thor synthetic population being used in making the invention, that Claims 2-4 would appear to remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Northrup et al, who teaches the synthetic variety Thor. The examiner added however, that the new matter of the selection of a singular and specific Thor clone on the basis of particular phenotypic and genotypic characteristics could obviate a rejection if the claims were amended to be limited to include a breeding step that would indicate a specific Thor selection step that could be read as an "improvement", and if the claims were amended to read on an invention of a specific population of alfalfa, wherein said invention is made with specifically disclosed and adequately described alfalfa clones. However, the examiner once again indicated that such an amendment would appear to require new matter in the instant specification, and that new matter was not allowed in the instant application.

In summary, the examiner suggested that a more specific and detailed disclosure of the making of the DS9705Hyb invention, as discussed in this interview, be included in a C-I-P filing of an application that claims priority to the instant application, and that said C-I-P application would be more favorably considered by the examiner. Applicant indicated that they intended to file a Continuation-In-Part application as suggested by the examiner.